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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,106	02/16/2001	Martin Sugar	BEIERSDORF 7	3482

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EXAMINER
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WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/02/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/763,106

Applicant(s)

SUGAR ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 7, 12-17 are pending. The Amendment filed 12/23/02, Paper No. 12, amended claims 7 and 13.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/14/03 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reducing, does not reasonably provide enablement for preventing adherence of lauryl ether sulfate to the skin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

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(1) The nature of the invention:

The invention provides a method for preventing or reducing the attachment of a lauryl ether sulfate to human skin during a washing process, said method comprising applying said lauryl ether sulfate to the human skin in a deterative cosmetic or dermatological preparation comprising the lauryl ether sulfate and more than 3% by weight of N-acylamino acids and/or salts thereof.

(2) The state of the prior art

The prior art teaches compositions comprising lauryl ether sulfate and more than 3% N-acylamino acid as good shampoos.

(3) The relative skill of those in the art

The relative skill of the those in the shampoo art is high, as it is a well-established art. See for example, Section 5 of the Handbook of Cosmetic Science and Technology, which teaches the level of skill of those in the shampoo art.

(4) The predictability or unpredictability of the art

The predictability of the shampoo art is very high, as most shampoo ingredients and their properties are well known.

(5) The breadth of the claims

The claims are very broad. The open ended language encompasses any and all ingredients and the claims can encompass any amounts and ratio of amounts of lauryl ether sulfate to N-acylamino acid and/or salts.

(6) The amount of direction or guidance presented

The specification discloses compositions that reduce the amount of lauryl ether sulfate to human skin and desorb lauryl ether sulfate from human skin. However, the specification does not provide any written description of composition that would prevent lauryl ether sulfate from adhering to the skin.

The Examiner respectfully directs Applicant to *In re Dreshfield*, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), which gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases," 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail. A disclosure should contain representative examples which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See *In re Riat et al.* (CCPA 1964) 327 F2d 685, 140 USPQ 471; *In re Barr et al.* (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

(7) The presence or absence of working examples

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In the instant specification, examples are drawn to composition formulations. However, no examples are directed to a method of preventing the adherence of lauryl ether sulfate to the skin.

(8) The quantity of experimentation necessary

Since the significance of the combination of lauryl ether sulfate and N-acylamino acids and/or salts in various ratios and weight amounts, and in combination with other ingredients cannot be predicted a priori but must be determined from the case to case by painstaking experimental study and when the above factors are weighed together, one of ordinary skill in the art would be burdened with undue "painstaking experimentation study" to determine the all of the formulations which would prevent the adherence of lauryl ether sulfate to the skin.

Preventing the adherence of lauryl ether sulfate to the skin is inconsistent with what is known in the art since (1) reduction of adherence indicates that adherence is decreased, but not prevented; and (2) elimination of adherence indicates that symptoms of adherence may occur. Furthermore, prevention of adherence indicates that the subject *never* experiences any characteristics associated with adherence. Hence, the amount of guidance present in the specification, the absence of data indicating that the symptoms of adherence do not occur when a composition comprising lauryl ether sulfate and N-acylamino acid and/or salt is administered, and, all indicate that treatment, not prevention of adherence is possible.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Mager et al. (JP 09-301834).

Mager et al. exemplify a hair washing agent comprising 1-14% N-acylglutamate and 1-14% sodium lauryl ether sulfate that is applied to the hair. See abstract.

It is respectfully pointed out that application of a shampoo to hair also results in application of the composition to the scalp.

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The claims are directed to a method of applying a composition comprising lauryl ether sulfate and more than 3% N-acylamino acids and/or salts to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce the attachment of a lauryl ether sulfate or desorb a lauryl ether sulfate from human skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

It is respectfully noted that claim 7 has been examined as a method of reducing.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

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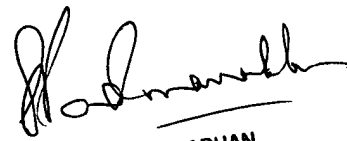
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

April 9, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

4/10/03